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Hearing: Paper No. 43
October 24, 2001 BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Tampa Rico, Inc.
v.
Puros Indios Cigars, Inc.

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Opposition No. 103,752
to application Serial No. 75/056,004
filed on February 9, 1996

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David W. Pettis, Jr. of Pettis & Van Royen, P.A. for Tampa Rico, Inc.

Robert M. Schwartz and Kevin O'Grady of Ruden McClosky Smith Schuster & Russell, P.A. for Puros Indios Cigars, Inc.

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Before Quinn, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Puros Indios Cigars, Inc. (a New Jersey corporation) filed on February 9, 1996, an application to register on the Principal Register the mark ROLANDO for cigars. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Tampa Rico, Inc. (a Florida corporation) has opposed registration of applicant's mark, alleging that it has been continuously using the mark ROLANDO for cigars "for approximately two (2) years" (the notice of opposition was filed on October 15, 1996); that on April 2, 1996, opposer filed application Serial No. 75/082,832 for the mark ROLANDO HANDMADE IMPORTED and design for "cigars, cigar boxes, cigar packaging"[1]; and that applicant's mark, if used in connection with cigars, would so resemble opposer's previously used mark as to be likely to cause confusion, mistake, or deception.

Applicant denied the allegations of the notice of opposition, and stated as an affirmative defense that "applicant has priority of use of the mark ROLANDO, over Opposer's alleged use."

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Don Barco, opposer's treasurer; opposer's notice of reliance on applicant's responses and supplemental responses to

[1] The Board notes that application Serial No. 75/082,832 was filed by Tampa Rico Cigar Co., Inc. (a Florida corporation); and that said application stands abandoned as of June 1997. In addition, the records of this Office indicate that Tampa Rico Cigar Company, Inc. owns application Serial No. 75/281,037 for the mark ROLANDO (in stylized lettering) for cigars; and that action on said application has been suspended in Law Office 115. Thus, it appears that there is a mistake in opposer's name as set forth in this opposition. (See also, the testimony of Don Barco, opposer's treasurer, pp. 4-5.)

opposer's first set of interrogatories; the testimony upon written questions, with exhibits, of Rolando Reyes, a third-party witness taken by applicant; and applicant's notice of reliance on (i) opposer's responses to applicant's first set of interrogatories, and (ii) an article from the Winter 1995/1996 Cigar Aficionado magazine to show the "renown of Mr. Rolando Reyes, Sr. in the cigar industry," and that "applicant's trademark rights in the mark Rolando, for cigars, derives from the applicant's prior long-standing use of the trademark Rolando Reyes, Sr. for cigars."

Both parties filed briefs, and an oral hearing was held before this Board on October 24, 2001.

With regard to the issue of priority, the record in this case establishes that opposer has continuously used the mark ROLANDO on cigars since April 28, 1995 (see, e.g., opposer's answer to applicant's interrogatory No. 4, and Barco dep., pp. 9-10 and 72); and that applicant has not used the mark ROLANDO on cigars (see applicant's response and supplemental response to opposer's interrogatory No. 6), leaving applicant to the filing date of its intent-to-use application (February 9, 1996). Applicant contends, however, that it has used the term ROLANDO as part of its composite mark ROLANDO REYES for cigars since approximately

1980. Thus, in order for applicant to prevail on priority, it must be able to "tack on" its use of the mark ROLANDO REYES.

A party seeking to "tack" its use of an earlier mark onto its later mark for the same goods may do so only if the earlier and later marks are legal equivalents, or are indistinguishable from one another. To meet the legal equivalents test, the marks must create the same commercial impression, and cannot differ materially from one another. (The fact that two marks may be confusingly similar does not mean that they are legal equivalents for the purpose of "tacking.") See Lincoln Logs Ltd. V. Lincoln Pre-Cut Log Homes Inc., 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992); Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); and Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 188 USPQ 485 (CCPA 1976).

It is clear that the marks ROLANDO and ROLANDO REYES do not create the same commercial impression, and that they differ materially from one another for purposes of "tacking" on an earlier date of first use. Simply put, these marks are not legal equivalents and applicant cannot

"tack" onto its filing date for the mark ROLANDO, its earlier use date of the mark ROLANDO REYES.[2]

We find that opposer has priority in this opposition proceeding.

As explained previously, applicant seeks to register the mark ROLANDO for cigars, and opposer has established prior use of the mark ROLANDO for cigars. We therefore find that there is a likelihood of confusion in this case involving the identical mark for the identical goods. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Decision: The opposition is sustained, and registration to applicant is refused.

[2] Because applicant's two involved marks are not legal equivalents, we need not address the sufficiency of applicant's evidence of its use of the mark ROLANDO REYES for cigars in this case.